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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/524,109

12/09/2005

Harlan A. Hurwitz

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EXAMINER

KIM, STEVEN S

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/524,109	Applicant(s) HURWITZ ET AL.	
	Examiner STEVEN KIM	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 19, 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 21-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10-Feb-2005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to the Application No. 10/524,109, which was filed on December 10, 2005.

Status of claims

2. Preliminary amendment, received on December 10, 2005, is acknowledged. The amendment cancels claims 21-33.
3. Claims 1-20 are pending.
4. Claims 1-20 are reviewed.
5. Claims 21-33 are cancelled.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
8. In regards to claim 1, the recited methods in claim 1 are broad enough to read on a person performing steps consisting of determining that a payment media handling operation event has occurred during the operation of the payment media handling apparatus; informing a responsible party of the payment media handling operation event; and providing a set of instructions to the responsible party on possible action steps to resolve the payment media handling operation event.

9. In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.
10. Similarly, claims 2-11 are rejected as described above.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
12. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
13. In regards to claim 1, 13 and 20, the Applicant recites "possible action steps". The term "possible" in the claims is a relative term which renders the claim indefinite. The term "possible" is not defined by the claim. Furthermore, the specification does not provide a standard for ascertaining the requisite degree. One of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

14. Claims 2-12 and 14-19 are rejected similarly as described previously as each depends on claim 1 or 13.

15. In regards to claims 8 and 14, the claims recite the limitation "the retail store". There is insufficient antecedent basis for this limitation in the claim.

16. In regards to claims 2 and 15, the claims recites the limitation "a payment media handling apparatus electronic coupling event", which renders the claim indefinite. One of ordinary skill in the art would not be reasonably ascertain the scope of the invention.

17. In regards to claim 20, the claim is directed toward a system, i.e. an output device and a controller. However, the claim is also directed to controller that determines, informs and provides. It is unclear whether the Applicant is claiming the apparatus or the functions of the apparatus. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone.

18. In regards to claims 4-7, the claims are indefinite since each rely on a specific "payment media handling operation event" to happen in claim 2, on which claims 4-7 depend. For example, if the payment media handling operation event is chosen to be a payment handling operation error in claim 2, then claim 5 renders indefinite since claim 5 is directed towards payment media handling apparatus electronic coupling event.

Claim Rejections - 35 USC § 102

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

20. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Drummond et al., US Patent Application No. 2005/0096994, hereinafter referred to as “Drummond”.

21. In regards to claims 1, 10 and 20, Drummond discloses a method and system comprising:

- determining that a payment media handling operation event has occurred during the operation of the payment media handling apparatus (see ¶0148-¶0150; Fig. 1; Fig. 2);
- informing a responsible party of the payment media handling operation event (see ¶0148-0153); and
- providing a set of instructions to the responsible party on possible action steps to resolve the payment media handling operation event, wherein the set of instructions comprises at least an audio and visual message (see ¶0148-¶0153).

22. In regards to claims 2, 4-7 and 15-18, Drummond further discloses wherein the payment media handling operation event comprises at least one of a payment media handling apparatus error, a payment media handling apparatus electronic coupling event, a payment media handling apparatus operation question and a payment media processing event (claim 2) (see ¶0148; ¶0154);

- (claims 4 and 16) wherein the payment media handling apparatus error comprises at least one of a payment media note jam, a payment media coin jam, a payment media note misfeed, a payment media coin misfeed, a payment media note double feed, an unauthorized payment media activity and a fraudulent payment (see ¶0148; ¶0154);
- (claims 5 and 17) wherein the payment media handling apparatus electronic coupling event comprises an event which identifies that the payment media handling apparatus is coupled to another electronic device (see ¶0148 - ¶0154; Fig. 2; ¶0053-¶0057; ¶0137); and
- (claims 6 and 18) wherein the payment media processing event comprises one or more events associated with performance of a payment media operation (see ¶0148-¶0154, fault and status are part of performance of a payment media operation);
- (claim 7) wherein the payment media operation includes at least one of a payment media acceptance operation, a start fund operation, a payment media change dispensing operation, a payment media

advance operation and a payment media bank deposit operation (see Fig. 2, Cash Dispenser 42; claim 12, level of currency; claim 10; ¶0148).

23. In regards to claims 3 and 13, Drummond also teaches wherein the set of instructions further comprises one or more of a visual message, an audio message and a text message (see ¶0151).

24. In regards to claim 8 and 14, Drummond further teaches wherein the responsible party includes at least one of a payment media handling apparatus user, a supervisory entity in the retail store, a supervisory entity not physically located in the retail store, a payment media handling apparatus repair representative, a security representative and a law enforcement official (see ¶0151, technician; ¶0034; ¶0153-¶0154; Fig. 1).

25. In regards to claims 9 and 19, Drummond also discloses wherein the audio and visual message comprises at least one of a computer slide presentation and a video presentation (see ¶0101, use of HTML document to present video and sound and ¶0151).

26. In regards to claim 10, Drummond further a method comprising prompting the responsible party, prior to the providing step (in claim 1), whether it wants to receive the set of instructions (see ¶0097; ¶0116; ¶0145; ¶0153).

27. In regards to claim 11, Drummond further discloses wherein the step of determining that the payment media handling operation event has occurred comprises performing at least one of a payment media handling apparatus self-diagnostic action and a payment media handling apparatus self-correcting action (see ¶0151 - ¶0154; ¶0163).

Conclusion

28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Gill et al. (US Patent No. 5,984,178): discloses fault monitoring and notification system and method for financial machine.
- Kobayashi et al. (US Patent No. 6,014,649): discloses supporting method and system for supporting ATM operations.

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN KIM whose telephone number is (571)270-5287. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:00PM).

30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

31. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. K./
Examiner, Art Unit 3685

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685